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*The Intellectual Property Law Section of the State Bar of California presents*

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# The Patent Office Comes to California

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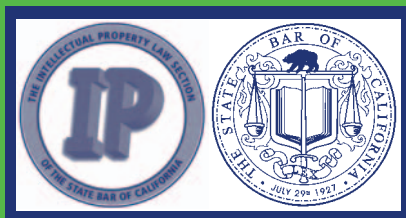
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**Monday, June 6, 2005**

The Westin Los Angeles Airport  
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**Tuesday, June 7, 2005**

The Westin San Francisco Airport  
1 Old Bayshore Highway  
Millbrae, CA 94030  
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# P R O G R A M

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**7:30 AM – 8:30 AM**

## **Registration & Continental Breakfast**

**8:30 AM – 8:45 AM**

## **Welcome & Opening Remarks**

*Scott Hansen, Fulwider Patton Lee & Utecht, LLP*

*R. Dabney Eastham, Law Office of R. Dabney Eastham*

**8:45 AM – 9:30 AM**

## **Trilateral Commission on Patent Harmonization**

On February 3-4, 2005, the USPTO hosted an “exploratory” meeting of representatives from the European Patent Office, the European Commission, the member states of the European Patent Convention, Japan, Canada and Australia to discuss approaches for facilitating international patent law harmonization. The meeting resulted in a very positive “Statement of Intent,” which outlined how the participants would coordinate in the future in order to maximize their effectiveness in achieving objectives at the World Intellectual Property Organization. This program will discuss this initiative and other Trilateral (USPTO, EPO, and JPO) initiatives to harmonize patent law which may lead to substantive changes in U.S. patent law and practice.

*Lois E. Boland, Director, Office of International Relations, United States Patent and Trademark Office, Washington, D.C.*

**9:30 AM – 10:15 AM**

## **Update on Patent Rule Changes**

This presentation will update IP professionals of the impact of recent significant rule makings on Office practice and procedure. The emphasis will be on the changes to patent fees as a result of the Consolidated Appropriations Act (CAA) of 2005, and the application of 35 U.S.C. § 103(c) as amended by the CREATE Act. An overview of the most significant changes to patent practice (e.g. 37 C.F.R. §§ 1.4, 1.17, 1.57, 1.111, 1.115) made by the 21st Century Strategic Plan final rule making will be covered. The standard for establishing a substantial new question (SNQ) for a subsequent reexamination proceeding and a proposed request for continued reexamination (RCR) will also be discussed.

*Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, D.C.*

**10:15 AM – 10:30 AM—Break**

**10:30 AM – 11:15 AM**

## **Patent e-Processing at the USPTO**

More and more business with the federal government is being conducted electronically, from electronic case filing in district court to electronic filing of tax returns. This program will discuss the Patent Office program for electronic filing and prosecution of patent applications and preview the changes that patent practitioners may expect to come.

*Terri R. Raines, Project Manager for Patents Electronic Filing, Search and Information Resources Administration, United States Patent and Trademark Office, Washington, D.C.*

**11:15 AM – 12:00 Noon**

## **Written Description Examination Guidelines**

In January 2001, the USPTO adopted guidelines for its examiners to use when assessing the written description for claimed inventions. This program will briefly review the foundations for the guidelines, and some examples from the training materials the USPTO provided for its examiners. The Court of Appeals for the Federal Circuit commented on the USPTO guidelines in some of its recent opinions, and this program will discuss the issues in several of those cases.

*Stephen G. Walsh, Associate Solicitor, Office of the Solicitor, United States Patent and Trademark Office, Washington, D.C.*

# SCHEIDULE

**12:00 PM – 1:30 PM**

## **Luncheon and Keynote Address**

*Luncheon Speaker (TBD)*

**1:30 PM – 1:45 PM—Break**

**1:45 PM – 2:30 PM**

## **Changes to Practice before the Board of Patent Appeals and Interferences**

Practice before the Board of Patent Appeals and Interferences has undergone not only procedural change but substantive change as well. The Patent and Trademark Office has recently issued new rules of practice that has changed the practice before the Board. Also, the U. S. Court of Appeals for the Federal Circuit has handed down many important rulings on issues of Board practice, claim interpretation and deference to the Board's fact findings that has impacted the practice before the Board. Administrative Patent Judge Michael R. Fleming will discuss these changes and give pointers to avoid common pitfalls.

*The Honorable Michael R. Fleming, Administrative Patent Judge, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, Washington, D.C.*

**2:30 PM – 3:30 PM**

## **Changes to Procedures Regarding Enrollment and Discipline for Patent Practitioners**

The USPTO has issued proposals for major revisions of its rules governing practitioners before the Office. It last year adopted new rules on enrollment of new patent practitioners and is considering the comments it received on changes in its disciplinary system and rules of professional conduct. The speaker has been intimately involved in the project on revising the rules on practice. He will provide an update on both the promulgated enrollment rules and the Office's consideration of the other proposed changes.

*James A. Toupin, General Counsel, Office of the General Counsel, United States Patent and Trademark Office, Washington, D.C.*

**3:30 PM – 3:45 PM—Break**

**3:45 PM – 4:45 PM**

## **Panel Discussion: Industry Specific Trends, Followed by General Q & A**

*Lois E. Boland, Director, Office of International Relations, United States Patent and Trademark Office, Washington, D.C.*

*Robert J. Spar, Director, Office of Patent Legal Administration, United States Patent and Trademark Office, Washington, D.C.*

*Terri R. Raines, Project Manager for Patents Electronic Filing, Search and Information Resources Administration, United States Patent and Trademark Office, Washington, D.C.*

*Stephen G. Walsh, Associate Solicitor, Office of the Solicitor, United States Patent and Trademark Office, Washington, D.C.*

*The Honorable Michael R. Fleming, Administrative Patent Judge, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, Washington, D.C.*

*James A. Toupin, General Counsel, Office of the General Counsel, United States Patent and Trademark Office, Washington, D.C.*

*Selected California practitioners*

**4:45 PM – 5:00 PM**

## **Closing Remarks**

**5:00 PM – 6:00 PM—Hosted Reception**



# REGISTRATION INFORMATION

## **Online Registration**

**[www.calbar.ca.gov/ipsection](http://www.calbar.ca.gov/ipsection)**

## **Registration by Mail**

Your registration must be received **no later than Thursday, May 26, 2005**. Please send your completed registration form and check payable to The State Bar of California to:

### **Program Registrations**

**The State Bar of California**

**180 Howard Street**

**San Francisco, CA 94105-1639**

## **Registration by Fax:**

Fax to program registrations at 415-538-2368. Visa/Mastercard only. Credit card information is mandatory.

## **On-Site Registrations**

On-site registration opens at 7:30 AM and is subject to space availability.

## **Cancellation/Refunds**

Cancellations and request for refunds must be received in writing **no later than Thursday, May 26, 2005**. Substitute registrants are allowed, but must register in their own name.

## **MCLE Credit**

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## **Special Assistance**

Please call 415-538-2467 or TDD for speech and hearing impaired 415-538-2231.

## **Questions**

For registration information, please call 415-538-2508. For program content/Section information, please call 415-538-2375.

## **Audio Tapes**

Audio tapes of the program will be available with a complete set of program materials from Versa-Tape. To order, please call 800-468-2737.

# REGISTRATION FORM

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## *The Patent Office Comes to California*

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### *Registration Fees (check appropriate box)*

- ☐ **\$275** Members of the State Bar of California  
Intellectual Property Law Section
- ☐ **\$310** Non-Member of the State Bar of California Intellectual Property  
Law Section (2005 Section Membership Included)
- ☐ **\$325** All Registrations after May 20, 2005  
(2005 Section Membership Not Included)

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